

Serial No.: 10/646,470  
Filing Date: August 22, 2003

## **REMARKS**

Reconsideration is respectfully requested. Claims 1, 4, 9, 12, 15, 18, and 27-34 are pending. Claims 2, 3, 5-8, 10, 11, 13, 14, 16, 17, and 19-26 have been canceled. Claims 27-29 have been withdrawn. Claims 1, 9, and 18 have been amended. New claims 30-34 have been added. No new matter has been added due to the amendments. Amendment to and cancellation of the claims does not affect inventorship.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

### **Election/Restrictions**

The Examiner maintained that claims 27-29 remain withdrawn from further consideration.

Applicants reserve the right pursuant to 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected matter during the pendency of the present application.

### **Claim Amendments**

Claims 1, 9, and 18 have been amended to correct informalities. New claims 30-34 have been added. Support is found, for example, in paragraph [00187].

### **Claim Objection**

Claim 15 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependency form for failing to further limit the subject matter of the previous claim.

The Examiner states that:

Claim 9 from which claim 15 is dependent is directed to and limited to crystallization method, where 15 is directed to method of using the crystal in determining the protein structure. This claim 15 expands the scope of the method of claim 9. Applicants should note that the two methods are independent methods having different steps.

Applicants respectfully disagree. Claim 15 adds additional method steps. As such, claim 15 includes all the steps of claim 9 as well as the new additional steps. Therefore, claim 15 defines the meets and bound of the claimed invention by including all the limitations recited in claim 9 with further limitations. Therefore, the rejection is improper and should be withdrawn.

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**Claim Rejection Under 35 U.S.C. § 112**

Claims 1, 4-6, 9, 12-15, and 18 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully traverse.

Claims 5, 6, 13, and 14 have been canceled, rendering the rejections moot.

With regards to claims 1 and 9 (and claims dependent therefrom), the claims have been amended to recite the space group and unit cell dimensions, and as such, Applicants believe the rejections under 112, first paragraph for lacking written description and enablement should be withdrawn.

With regards to claim 18, the application meets the written description requirement because the application is sufficient to show that the inventor possessed the claimed invention. Applicants respectfully direct Examiner's attention to Example 13 of *Synopsis of Application of Written Description Guidelines* ("Guidelines").

Claim 1 of Example 13 claims "A isolated protein having SEQ ID NO: 3," where the specification has a working example showing the isolated protein was sequenced and determined to consist of SEQ ID NO:3. As stated in the Guidelines:

A search of the prior art indicates that SEQ ID NO: 3 is novel and nonobvious. The claim is directed to a genus of proteins that comprise SEQ ID NO :3. One member of the genus, SEQ ID NO: 3, is described by a complete structure.

The Guidelines go on to conclude:

The claimed subject matter is adequately described. A rejection under the written description requirement should not be entered.

Applicants submit that the instant application is substantial identical to Example 13. As such, instant claim 18 meets the written description requirement, and the rejection on this basis should be withdrawn.

Applicants further submit that the instant application also meets the enablement requirement because, as discussed above, the instant application not only discloses working examples, but also discloses how to make variants. The disclosure, taken in view of the general knowledge, enables a skilled artisan to practice the claimed invention without undue experimentation. As such, the rejection based on lacking of enablement is improper and should be withdrawn.

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**CONCLUSION**

Applicants respectfully submit that the claims are now in condition for allowance and early notification to that effect is respectfully requested. If the Examiner feels there are further unresolved issues, the Examiner is respectfully requested to phone the undersigned at (415) 442-1000.

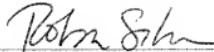
Respectfully submitted,  
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Dated:

3/26/07

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